

REMARKS

Claims 11-20 are pending in the present application. None of the claims have been amended in this response. As a follow-up from Applicant's telephone message to the Examiner on April 27, 2005, Applicant requests an Examiner Interview as of right.

Claims 11-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Irwin* (US Patent 5,862,136). Applicant traverses the rejection. Favorable reconsideration is respectfully requested.

Specifically, *Irwin* does not teach or suggest "generating a control signal sequence with a clock rate corresponding to the overall payload cell rate CR_N of the N time-division multiplex communication terminals, whereby control signals in the control signal sequence represent one of a first and a second status" as recited in claim 11 and similarly recited in claim 20. It follows that *Irwin* also fails to teach or suggest "transmitting, on demand, an ATM cell from the ATM waiting list to the requesting time-division multiplex communication terminal when a respectively oldest control signal of the control signal sequence represents the first status, and transmitting the fixed data pattern to the requesting time-division multiplex communication terminal when the oldest control signal of the control signal sequence represents the second status; and deleting the oldest control signal of the control signal sequence."

The Office Action apparently conceded that *Irwin* does not disclose *generating a control signal sequence* with a clock rate corresponding to the overall payload cell rate CR_N of the N time-division multiplex communication terminals, whereby control signals in the control signal sequence *represent one of a first and a second status* (see Office Action page 3, second full paragraph). Oddly enough, the Office Action goes on to claim that *Irwin* teaches transmitting, on demand, an ATM cell from the ATM waiting list to the requesting time-division multiplex communication terminal when a respectively *oldest control signal of the control signal sequence represents the first status*, and transmitting the fixed data pattern to the requesting time-division multiplex communication terminal when the *oldest control signal of the control signal sequence represents the second status*. Such a position is untenable in light of the disclosure in *Irwin*, and furthermore appears contradictory and inconsistent on its face.

When applying 35 U.S.C. §103, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole;

(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986) (MPEP 2141). Applicant respectfully submits that none of these requirements were met in the present Office Action.

If *Irwin* does not disclose a control sequence as claimed by the Examiner, how can *Irwin* also teach the feature where the oldest control signal assumes different states as recited in the claims? The Office Action cites FIG. 6, and argues that, since read counter 422 has limited storage capacity, an oldest signal is determined and removed (page 3 Office Action, lines 4-5). This is simply wrong. As the read counter is explicitly used to help control buffer traffic (col. 6, lines 58-65), the counter has nothing whatsoever to do with determining the oldest control signal. By definition, the read counter counts the read requests from the buffers – while a counter presumably has a non-infinite counting capacity, this fact has no relevance to the present claims. Furthermore, it is not understood how the counter determines whether a control signal takes on a first or second status as required by the claims.

Moreover, *Irwin* does not disclose a fixed data pattern. The passage in *Irwin* cited by the Examiner (col. 15, lines 48-49) describes how surplus bandwidth, which is transmitted by idle coded octets, is inserted into idle time slots by the input multiplexer. There is absolutely nothing in this passage, nor anywhere else in *Irwin* that these octets are in the form of fixed data patterns.

Finally, the Applicant is bewildered by the Office Action's claim that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a control signal sequence in the system of *Irwin*." Applicant can only presume that the Examiner discovered something inherent in the disclosure of *Irwin* (aside from the fact that ATM transmission occurs) that served as a basis for the obviousness contention. However, this basis is completely lost on the Applicant, and objective evidence for this position was wholly absent from the Office Action. As was argued previously, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In Re Rijckaert* 9 F.3d 1531, 1534, 28 USPQ2d 1955 (Fed. Cir. 1993) MPEP

§2112. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex Parte Levy* 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990), MPEP §2112.

Independent claims 11 and 20 are not simply reciting the bare transmission of ATM cells over time slots, but recite specific elements for coupling an ATM communication layer to a plurality of TDM terminals. By baldly asserting that "one could have easily used a control sequence to instruct the mechanism to output cells over time slots" using conclusory reasoning demonstrates that the rejection is improper and should be withdrawn.

For at least these reasons, Applicant respectfully submits that the claims as they presently stand are all in condition for allowance. Applicant therefore requests that the Examiner allow the claims and move the application to issue. However, if there are any remaining issues the Examiner is encouraged to call Applicant's attorney, Peter Zura at (312) 807-4208 in order to facilitate a speedy disposition of the present case.

If any additional fees are required in connection with this response they may be charged to deposit account no. 02-1818.

Respectfully submitted,

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